



402-038-19

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: David G. McCarthy

Serial No. 08/951,276

Filed: October 16, 1997

Title: Retractable Receptacle
For Furniture

Commissioner for Patents
Washington, D.C. 20231

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PETITION TO COMMISSIONER UNDER 37 CFR 1.181

I). INTRODUCTION

The above identified Applicant, by and through his undersigned attorney, hereby petitions the Commissioner under 37 CFR 1.181 to invoke his supervisory authority and vacate the decision in the Official Action dated March 7, 2003 by the Primary Examiner, the Supervisory Patent Examiner, and the Director of Technology Center 2800, re-opening prosecution of this application on the merits under 37 CFR 1.198 after decision by the Board of Patent Appeals & Interferences.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner of Patents & Trademarks, Washington, D.C. 20231, on April 10, 2003
(Date of Deposit)

Mark P. Stone
MARK P. STONE

Reg. No. 27,954

As more fully discussed herein, the re-opening of prosecution on the merits fails to comply with the express requirements set forth in 37 CFR 1.198.

II). STATEMENT OF FACTS

1). In a final action dated August 31, 1999, the Primary Examiner rejected Claims 1, 2, 6 and 16 under 35 U.S.C. Section 102(b) over the Byrne patent (U.S. Patent No. 4,747,788); rejected Claims 19 and 20 under 35 U.S.C. Section 102(b) over the Mitchell et al patent (U.S. Patent No. 4,511,198); and rejected Claims 3 - 5, 7 - 15 and 17 - 18 under 35 U.S.C. Section 103(a) over the Byrne patent (U.S. Patent No. 4,747,788). No claims were allowed.

2). On November 1, 1999, Applicant filed a Request For Reconsideration After Final Rejection;

3). In an Advisory Action dated November 16, 1999, the Examiner maintained the prior art rejection of the claims;

4). On December 2, 1999, Applicant filed a Notice of Appeal. Applicant's Appeal Brief which, inter alia, presented arguments rebutting the prior art rejections in the final action, was filed on January 19, 2000;

5). In the Examiner's Answer dated April 11, 2000, all prior art rejections were withdrawn. Paragraph 6 of the Examiner's Answer expressly states: "The appellant's statement of the issues in the brief is correct; the rejections under 35 USC 102 and 103 are withdrawn.";

6). On October 31, 2002, the Board of Patent Appeals And Interferences reversed all outstanding grounds of rejection under 35 U.S.C. 112 raised against appealed Claims 1 - 20; and

7). In an Official Action dated March 7, 2003, the Examiner re-opened prosecution on the merits and rejected all of the appealed Claims 1 - 20 over the same two prior art references (U.S. Patent Nos. 4,747,788 and 4,511,198) which were applied in the final rejection dated August 31, 1999, and which were expressly withdrawn from the appeal in the Examiner's Answer dated April 11, 2000.

III). ARGUMENT -

37 CFR 1.198 states:

"Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of Section 1.114 or Section 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown".

Applicant submits, based upon the facts set forth above, that the Examiner lacked authority under 37 CFR 1.198 to re-open prosecution on the merits after appeal and to apply the same prior art references expressly withdrawn by the Examiner in the Examiner's Answer prior to the decision on appeal.

37 CFR 1.198 imposes two requirements on cases re-opened after decision by the Board, namely, 1). that the case can be re-opened only for the consideration of matters not already adjudicated, and 2). that sufficient cause for re-opening prosecution be shown.

In the instant case, the Examiner has re-opened the prosecution for consideration of matters which have already been adjudicated by the Board. The express withdrawal of all prior art rejections in the Examiner's Answer based upon the two prior art patents applied in the final rejection, after Applicant had argued against these prior art rejections in his Appeal Brief, constitutes an adjudication of these rejections in Applicant's favor by default. Although the March 7, 2003 Official Action applies the same two prior art patents in a different manner than they were applied in the final rejection, the current rejections are nonetheless based on the identical prior art patents withdrawn by the Examiner during appeal. The Examiner had the authority to re-open prosecution to withdraw the prior art rejections in the final action based on the arguments advanced in Applicant's Appeal Brief and enter a new ground of rejection

applying the two prior art patents in a different manner prior to the Board's decision on appeal (Manual of Patent Examining Procedure, 8th Edition, August 2001, Section 1208.02), but elected not to do so.

The withdrawal in the Examiner's Answer of the prior art rejections based on the two prior art patents applied in the final action in response to the arguments advanced in Applicant's Appeal Brief, and the failure by the Examiner to enter any new grounds of rejection based on these two patents prior to the decision on appeal, results in an adjudication in Applicant's favor, by default, that the appealed Claims 1 - 20 define patentable subject matter over these two prior art patents. The Official Action dated March 7, 2003, rejecting the same appealed claims over the same two prior art patents withdrawn in the Examiner's Answer, is therefore directed to matters already adjudicated by the decision on appeal, and prosecution on the merits cannot be re-opened under 37 CFR 1.198 to address these matters.

* * *

The Official Action dated March 7, 2003 fails to show sufficient cause for re-opening prosecution on the merits, as expressly required by 37 CFR 1.198. In fact, the Official Action does not even address the issue of sufficient cause, nor acknowledge that the rejections being made are based upon the two

identical prior art patents applied in the final action and thereafter expressly withdrawn in the Examiner's Answer during the appeal. The Examiner was clearly aware of the existence of the two prior art references applied in the March 7, 2003 Official Action before the decision of the Board on appeal and, as discussed above, could have re-opened prosecution on the merits to apply these two prior art patents in the manner applied in the March 7, 2003 Official Action prior to the Board's decision. Yet, the Official Action fails to make any showing or provide any explanation as to why the two prior art patents applied in the March 7, 2003 Official Action were not, or could not have been, applied by the Examiner to make the rejections first made in the March 7, 2003 Official Action before the decision by the Board on the appeal. Therefore, the Examiner has failed to make a sufficient showing for re-opening of prosecution on the merits after decision on appeal, as required by 37 CFR 1.198.

IV). CONCLUSION -

Applicant submits that the Official Action dated March 7, 2003, re-opening the prosecution after decision by the Board on appeal, fails to comply with the requirements of 37 CFR 1.198,

and requests that the Examiner be directed to withdraw the prior art rejections of the claims made in the Official Action dated March 7, 2003.

Respectfully submitted,



Mark P. Stone
Reg. No. 27,954
Attorney for Applicant
1100 High Ridge Road
Stamford, CT 06905
(203) 329-3355